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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* CHRISTOPHER W. RAMIREZ and  
JAMES A. HOWELL, JR.

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Appeal 2008-1853  
Application 10/672,130  
Technology Center 3600

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Decided: June 23, 2008

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Before WILLIAM F. PATE, III, HUBERT C. LORIN, and  
DAVID B. WALKER, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Christopher W. Ramirez, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1, 3-11, and 13-20. Claims 2 and 12 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF DECISION

We AFFIRM.<sup>1</sup>

### THE INVENTION

The invention relates to a “process for restoring upgrade keys or promotional offers using unique identifiers.” (Specification 1:8-9). In one embodiment of the invention, a value that uniquely identifies an information handling system is linked with a promotion code value for the information handling system to re-enable a benefit identified by the promotion code value, and during remote restoration, the promotion code value for the information handling system is obtained by providing the value that uniquely identifies the information handling system. (Specification 4:17-25).

Claims 1 and 11 are illustrative of the invention.

1. A method for enabling remote restoration of a purchase verification, comprising:
  - obtaining a value that uniquely identifies an information handling system;
  - obtaining a promotion code value that identifies a benefit;
  - linking the value that uniquely identifies the information handling system with the promotion code value for the information handling system;
  - during remote restoration, obtaining the promotion code value for the information handling system by providing the value that uniquely identifies the information handling system; and,
  - providing the promotion code value to the information handling system to re-enable the benefit;

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<sup>1</sup> Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed Jul. 10, 2007), the Examiner’s Answer (“Answer,” mailed Oct. 18, 2007), and the Reply Brief (“Reply Br.,” filed Dec. 18, 2007).

installing application software in an information handling system memory when the information handling system is assembled at a manufacturing facility; and,

linking any promotion code values with the value that uniquely identifies the information handling system within an order management system.

11. A system for enabling remote restoration of a purchase verification, comprising:

a restore module, the restore module being configured to:

obtain a value that uniquely identifies an information handling system;

obtain a promotion code value that identifies a benefit;

link the value that uniquely identifies an information handling system with the product code value for the information handling system;

during remote restoration, obtain the promotion code value for the information handling system by providing the value that uniquely identifies the information handling system; and,

provide the promotion code value to the information handling system to re-enable benefit;

an install module, the install module installing application software on an information handling system memory when the information handling system is assembled at a manufacturing facility; and,

a link module, the link module linking any promotion code values with the value that uniquely identifies the information handling system within an order management system.

## THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Horstmann	US 6,009,401	Dec. 28, 1999
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The following rejection is before us for review:

- Claims 1, 3-11, and 13-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Horstmann.

### ISSUES

The issue is whether the Appellants have shown that the Examiner erred in rejecting claims 1, 3-11, and 13-20 as being anticipated by Horstmann. A major issue is whether Horstmann describes the claimed limitations of “remote restoration” and “promotion code.”

### FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office). Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2007).

1. The Examiner found that Horstmann explicitly describes all the claimed limitations. Answer 3-11.
2. The Appellants disagreed with the Examiner and focused on the claim terms “remote restoration” and “promotion code,” drawing our attention to discussion of these terms in the Specification at page 3,

line 29 – page 4, line 3 and page 3, lines 15-28, respectively. App.  
Br. 5.

3. The passage at page 3, line 29 – page 4, line 3 of the Specification reads as follows:

One issue that arises when using a product key relates to when a client performs a software re-install or hard drive replacement on a computer system which includes a product key. In this situation, there is not a seamless way to retore the promotional offer or client upgrade keys to the computer system, or to even know what offers the user of the computer system was originally authorized to purchase. Often the client contacts the vendor via telephone to obtain the product keys and then manually re-enters the product keys onto the computer system.

4. The passage at page 3, lines 15-28, of the Specification reads as follows:

One approach for addressing the above concerns is to issue a "product key" or password to the purchaser that encodes whether or not particular goods or services are included and, if so, identifies the good or services. The product key may be printed on a certificate that is delivered with the computer system. Alternatively, the product key may be generated by computer and e-mailed to the purchaser. When the purchaser has received the computer, he manually types the product key into the computer when attempting to gain access to the-pre-purchased goods or services. This approach presents several disadvantages. First, with either the printed or computer-generated approach, the customer will be denied access unless he properly types the product key into the computer when it is requested. This feature could prevent, due to a typographical error, the purchaser from accessing goods or services for which he has already paid. With the printed product key approach, there is also the risk that the certificate bearing the printed product key will become destroyed, lost, or otherwise inaccessible to the purchaser.

## PRINCIPLES OF LAW

Anticipation is a question of fact. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

## ANALYSIS

The Appellants argued claims 1, 3-11, and 13-20 as a group (App. Br. 3). We select claim 1 as the representative claim for this group and the remaining claims 3-11 and 13-20 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Horstmann describes all the claimed limitations. FF 1. The Appellants disagreed on the ground that “the Examiner is not providing sufficient patentable weight to the terms ‘remote restoration’ and ‘promotion code’”. (App. Br. 5).

Regarding “remote restoration,” the Examiner clearly explained in the Final Rejection (p. 1) that no functional difference could be ascertained between the claimed “remote restoration” and the “remote downloading” described at col. 4, lines 6-11 and col. 5, line 10, of Horstmann. The Examiner appeared to take the position that, but for the difference in terms, the claimed “remote restoration” and Horstmann’s “remote downloading”

were one and the same. The Answer repeats this position (Answer 4), buttressed with reliance on other passages in Horstmann (i.e., col. 2, lines 62-63; col. 3, lines 63-65; col. 4, line 66-col. 5, line 16, col. 5, lines 23-27; and, col. 4, lines 6-25) (Answer 12-13). Also, to further illustrate the Examiner's position, an Appendix comparing claim limitations, including "remote restoration," with what Horstmann describes is attached to the Answer. All of this detailed analysis in an effort to determine whether Horstmann describes the claimed "remote restoration" belies the Appellants' criticism that the Examiner did not provide sufficient patentable weight to the claim term "remote restoration."

The Appellants further argue that the term "remote restoration" "has meaning within the art in which the invention resides and those skilled in the art would appreciate the distinction[] presented for by [this] term." App. Br. 5. The difficulty with this argument is that there is no evidence to substantiate the thrust of the Appellants' argument that the term "remote restoration" has a meaning in the art and to those skilled in the art that differs from the one the Examiner used to equate "remote restoration" with Horstmann's "remote downloading." Appellants' attorney's arguments in a brief cannot take the place of evidence in the record. *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974); *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984); *Meitzner v. Mindick*, 549 F.2d 775 (CCPA 1977), *cert. denied*, 434 US 854 (1977), and *In re Schulze*, 346 F.2d 600 (CCPA 1965).

The Appellants draw our attention to page 3, line 29 – page 4, line 3 of the Specification. App. Br. 5. We have read the indicated disclosure. See FF 3. Not only do we not find there any definition to be given the term "remote restoration" which would be different from the one the Examiner



used to equate “remote restoration” with Horstmann’s “remote downloading,” but the term “remote restoration” is not even mentioned.

Regarding the claim limitation “promotion code,” it, too, is comprehensively addressed in the Final Rejection (p. 2) and Answer (pp. 4, 11-2, and the Appendix). The Examiner’s detailed analysis in an effort to determine whether Horstmann describes the claimed “promotion code” belies the Appellants’ criticism that the Examiner did not provide sufficient patentable weight to the claim term “promotion code.”

As with the term “remote restoration,” the Appellants argue, without supporting evidence, that the term “promotion code” “has meaning within the art in which the invention resides and those skilled in the art would appreciate the distinction[] presented for by [this] term.” App. Br. 5. However, Appellants’ attorney’s arguments in a brief cannot take the place of evidence in the record. See earlier citations.

The Appellants draw our attention to page 3, lines 15-28 of the Specification. App. Br. 5. We have read the indicated disclosure. See FF 4. Not only do we not find there any definition to be given the term “promotion code” which would be different from the one the Examiner used, but the term “promotion code” is not even mentioned. The passage discusses “product key[s]” or passwords. Given this, we see nothing that would undermine the Examiner’s view that there appears to be no difference between the claimed “promotion code” and Horstmann’s license number (see Horstmann, e.g., col. 4, line 6). See Answer 12.

For the rest, the Appeal Brief and Reply Brief point to various claim limitations and conclude, with no analysis, either that “[n]owhere in Horstmann is there any teaching or suggestion” or “Horstmann does not

teach or suggest” them. App. Br. 5-7 and Reply Br. 1-2. The Examiner made a concerted effort to show where in Horstmann these argued-for limitations are described. The Examiner’s analysis has not been rebutted. A general allegation that the art does not teach any of the claim limitations is no more than merely pointing out the claim limitations. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. 41.37(c)(1)(vii).

The Appellants’ arguments have been carefully considered but have not been found persuasive as to error in the rejection.

#### CONCLUSIONS OF LAW

The Appellants have not shown that the Examiner erred in rejecting claims 1, 3-11, and 13-20 as being anticipated by Horstmann.

#### DECISION

The decision of the Examiner rejecting claims 1, 3-11, and 13-20 under 35 U.S.C. § 102(b) as being anticipated by Horstmann is affirmed.

#### AFFIRMED

vsh

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